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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,611	12/21/2000	Thad R. Perry	10022/24	2184

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EXAMINER

COLON, CATHERINE M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/746,611

Applicant(s)

PERRY ET AL. *ES*

Examiner

C. Michelle Colon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The following is a Non-Final Office Action in response to the communication received on December 21, 2000. Claims 1-38 are now pending in this application.

#### ***Information Disclosure Statement***

2. The Examiner has reviewed the patents and publications supplied in the Information Disclosure Statement (IDS) provided on October 22, 2002.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites the limitation "the cost" in line 1. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Ruffin (U.S. 6,219,654).

As per claim 1, Ruffin discloses a method of evaluating a business proposal, comprising the steps of:

gathering information on the proposal (col. 2, lines 29-33; col. 3, lines 10-14; The reference discloses gathering information from customers to assess their solution needs for a proposal.);

accessing information on similar or analogous proposals (col. 4, lines 41-48; col. 7, lines 15-25; The reference discloses accessing information in a database of customers with similar requirements and needs.); and

evaluating the information by computer (col. 3, lines 38-64; col. 8, lines 48-60; The reference discloses a computer program tool and database for evaluating customers' business needs and generating proposals.).

As per claim 2, Ruffin discloses the method of claim 1, wherein information gathered further comprises at least one of revenue elements of the proposal, risks, descriptive information, business issues, business goals, a value of the proposal, methods of achievement of the proposal, and an innovation value of the proposal (col. 2, lines 29-33; col. 3, lines 53-64).

As per claim 3, Ruffin discloses the method of claim 1, wherein the information gathering step further comprises answering predetermined questions on at least one template stored in a computer (col. 4, lines 13-17 and 41-61; The reference discloses

gathering information from a customer via predetermined questions in a profile template.).

As per claim 4, Ruffin discloses the method of claim 3, wherein the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses that customers' answers to the predetermined questions can be used to call up additional templates such as financial, work assessment and planning tools.).

As per claim 5, Ruffin discloses the method of claim 1, wherein the business proposal is from a service provider to a customer (col. 2, lines 29-38; col. 3, lines 1-7; col. 6, lines 65-67).

As per claim 6, Ruffin discloses the method of claim 5, further comprising gathering information on a customer for the proposal, the agents of the customer or employees of the customer (col. 2, lines 29-38; col. 3, lines 1-34).

As per claim 7, Ruffin discloses the method of claim 1, wherein information concerning the customer, the customer's experience with the provider, or the provider's experience with other customers is available in a customer relationship repository of information (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 8, Ruffin discloses the method of claim 1, wherein information concerning the experience of the provider in providing the service is available in at least one database (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 9, Ruffin discloses the method of claim 1, wherein information concerning the benefits to the customer is available in at least one database (col. 10, lines 25-34; col. 14, lines 58-67; Figures 4 and 5).

As per claim 10, Ruffin discloses the method of claim 1, wherein the cost is calculated as a revenue stream to the service provider (col. 6, lines 47-54).

As per claim 11, Ruffin discloses the method of claim 1, further comprising the steps of calculating a benefit to the customer of providing said service to said customer (col. 9, lines 34-41; col. 10, lines 25-34; col. 12, lines 21-25; The reference discloses calculating whether a customer would benefit from the service of the service provider.).

As per claim 12, Ruffin discloses the method of claim 1, wherein information gathered for calculation further comprises an assessment of the proposal in light of present business considerations, risks of the proposal, or financial considerations of the proposal (col. 9, lines 21-41; col. 10, lines 10-34; col. 12, lines 21-33; The reference discloses assessing the proposal in light of the customer's present business considerations such as risks and financial matters.).

As per claim 13, Ruffin discloses the method of claim 2, wherein at least some of the information is gathered through the Internet, and further comprising the steps of updating the information and recalculating the cost (col. 7, lines 26-65; col. 9, lines 34-50; The reference discloses conducting Internet surveys to gather customer information and further updating the customer profile.).

As per claim 14, Ruffin discloses the method of claim 1, wherein the proposal comprises an offer of a service from the provider, and further comprising the step of

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calculating a way for the customer to pay for the service (col. 2, lines 29-33; col. 5, line 62-col. 6, line 11; col. 7, lines 6-40; col. 8, lines 3-20; col. 17, lines 44-52; col. 18, lines 40-62; The reference discloses offering IT services to customers as well as cost analyses in a proposal.).

As per claim 15, Ruffin discloses the method of claim 1, wherein the proposal is an alliance, an acquisition, an equity venture, a partnership, an offer for a service, or a venture (col. 5, line 62-col. 6, line 11; col. 7, lines 6-40; col. 8, lines 3-20).

As per claims 16 and 17, Ruffin discloses the method of claim 1, wherein the input/output is provided through a graphical user interface, and the input/output is in a form of brief numerical or pseudo-numerical outputs (col. 8, line 61-col. 9, line 20; Figure 4).

As per claim 18, Ruffin discloses a method of evaluating a business proposal, comprising:

searching at least one database for information concerning the customer, the proposal and a business environment (col. 3, lines 58-64; col. 4, lines 41-48; col. 5, lines 1-5; col. 7, lines 15-25; col. 8, lines 3-16; The reference discloses maintaining at least one database of information concerning customers, proposals and business environments.);

providing financial data concerning the proposal to a computer (col. 4, lines 49-61; col. 8, lines 10-17; col. 18, lines 9-20; The reference discloses using financial tools to assess solutions/proposals provided to a customer.);

proposing at least one structure for the business proposal, using said financial information and information from the database (col. 18, lines 21-62); and

calculating an advantage of the business proposal (col. 10, lines 25-38).

As per claim 19, Ruffin discloses the method of claim 18, wherein the database comprises a client relationship repository of information (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 20, Ruffin discloses the method of claim 18, wherein the database comprises at least one site on the Internet (col. 7, lines 26-65; col. 9, lines 34-50; The reference discloses conducting Internet surveys to gather customer information.).

As per claim 21, Ruffin discloses the method of claim 18, wherein the step of entering financial data comprises retrieving financial data from at least one database (col. 4, lines 49-61; col. 8, lines 10-17; col. 18, lines 9-20; The reference discloses using financial tools to assess solutions/proposals provided to a customer.).

As per claim 22, Ruffin discloses the method of claim 18, further comprising the step of entering information concerning at least one of risks, descriptive information, business environment, business issues, business goals, a value of the proposal, and methods of achievement of the proposal, for use by a computer in determining an advantage of the proposal (col. 2, lines 29-33; col. 3, lines 53-64).

As per claim 23, Ruffin discloses the method of claim 22, wherein the information is entered through at least one template stored in a computer (col. 4, lines 13-17 and 41-61; The reference discloses gathering information from a customer via a profile template.).



As per claim 24, Ruffin discloses the method of claim 23, wherein the information entered through at least one template calls up at least one template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses that customers' answers to the predetermined questions can be used to call up additional templates such as financial, work assessment and planning tools.).

As per claim 25, Ruffin discloses the method of claim 18, wherein the advantage is calculated as at least one revenue stream (col. 6, lines 47-54).

As per claim 26, Ruffin discloses the method of claim 18, wherein the advantage is calculated as at least one revenue stream and includes an example of how to pay for the service (col. 2, lines 29-33; col. 5, line 62-col. 6, line 11; col. 7, lines 6-40; col. 8, lines 3-20; col. 17, lines 44-52; col. 18, lines 40-62; The reference discloses offering IT services to customers as well as cost analyses in a proposal.).

As per claim 27, Ruffin discloses the method of claim 18, wherein more than one structure is proposed, and further comprising the step of comparing the advantage of each structure (col. 18, lines 21-62).

As per claim 28, Ruffin discloses the method of claim 18, wherein the advantage is recalculated by a step of entering updated data into the computer (col. 18, lines 21-62).

As per claim 29, Ruffin discloses the method of claim 18, wherein the step of searching comprises a search of at least one Internet site, and further comprising the steps of updating the search periodically, and updating the computer calculation of an

advantage periodically (col. 3, lines 38-64; col. 8, line 48-col. 9, line 66; The reference discloses providing customers the ability to interact with the BSA tool through a graphical interface over the Internet. When users enter information into the tool, the corresponding databases of information are updated.).

As per claims 30 and 31, Ruffin discloses the method of claim 18, wherein the input/output is provided through a graphical user interface, and the input/output is in a form of brief numerical or pseudo-numerical outputs (col. 8, line 61-col. 9, line 20; Figure 4).

As per claim 32, Ruffin discloses a computer system for evaluating a proposal, comprising:

- a computer processor (Figure 3);

- at least one memory operably connected to said computer, said memory containing data relevant to the proposal (col. 7, lines 6-65; col. 8, lines 10-16; col. 18, lines 54-62; Figures 2, 3 and 4);

- a computer program for evaluating the proposal, said program residing in said computer or in said memory (col. 7, lines 6-65; col. 8, line 48-col. 9, line 20; Figures 2, 3 and 4),

- wherein the computer program calculates an output helpful for evaluating the proposal (col. 9, lines 5-15; col. 18, lines 54-62; Figure 2).

As per claim 33, Ruffin discloses the computer system of claim 32, wherein the proposal is from a provider of goods or services to a customer (col. 2, lines 29-38; col. 3, lines 1-7; col. 6, lines 65-67).

As per claim 34, Ruffin discloses the computer system of claim 32, wherein the data comprises information concerning the proposal, a customer, experience of the provider with the customer, or experience the provider has had with this or other customers (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 35, Ruffin discloses the computer system of claim 32, wherein the computer program further comprises at least one template of predetermined questions, and the computer program uses the answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses gathering information from a customer via predetermined questions in a profile template.).

As per claim 36, Ruffin discloses the computer system of claim 32, wherein the answers to at least one predetermined question call up at least one more template of predetermined questions, and the computer uses answers to said questions to evaluate the proposal (col. 4, lines 13-17 and 41-61; The reference discloses that customers' answers to the predetermined questions can be used to call up additional templates such as financial, work assessment and planning tools.).

As per claim 37, Ruffin discloses the computer system of claim 1, wherein information concerning the customer, the customer's experience with the provider, or the provider's experience with other customers is available in a customer relationship repository of information (col. 4, lines 41-48; col. 7, lines 15-25; col. 8, lines 48-60).

As per claim 38, Ruffin discloses the computer system of claim 32, wherein the computer program uses a technique of control-action-response in seeking and inputting information from a user of the computer system (col. 4, lines 49-67; col. 8, line 61-col. 9,

line 20; Figure 4; The reference discloses a question and answer engine tool that controls the seeking and inputting of information from a user.).

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nagai et al. (U.S. 6,347,303) discusses a system configuration proposal;
- Ruffin et al. (U.S. 6,249,769) discusses a system and method for evaluating the business requirements of an enterprise for generating business solution deliverables;
- Ruffin et al. (U.S. 6,526,387) discusses a system and method for determining the value of a proposed technology modification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Thursday from 8:30am to 5:30pm and every other Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Any response to this action should be mailed to:

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or faxed to:

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703-746-7202 [For status inquiries, draft communication, labeled  
"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA 7<sup>th</sup> floor receptionist.

*cmc*  
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May 14, 2003

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